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09/912,290	07/24/2001	Blake B. Bogrett	7150	5201

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EXAMINER

PIERCE, JEREMY R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/912,290
Filing Date: July 24, 2001
Appellant(s): BOGRET ET AL.

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John D. Lister
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 27, 2005 appealing from the Office action mailed June 9, 2004.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct. However, Appellant has mistakenly stated that claims 1 to 9 depend from claim 1. It is noted that only claims 2 to 9 depend from claim 1.

(4) Status of Amendments

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. The amendment after final rejection filed on September 27, 2004 has been entered.

(5) Summary of the Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Prior Art of Record

WO 94/16162	Brandt et al.	7-1994
US 5,765,318	Michelsen	6-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

A. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites a "single blanket of resilient fibrous insulation having no folds therein." However, there is no support for a single blanket of resilient fibrous insulation having no folds therein in the specification. Negative limitations are not allowed in the claim unless expressly set forth in the specification. *Ex parte Grasselli*, 231 USPQ 393. The specification does not indicate that the fibrous layer must exclude folds. While the article disclosed in the specification might not have folds, the specification does not teach the concept of excluding folds, which is now recited in the claims.

B. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Brandt et al. (WO 94/16162).

Brandt et al. disclose an insulating web comprising a fibrous non-woven web (page 1, lines 5-14). The fibers are generally oriented in a single predominant orientation determined by the orientation of the production line (page 1, lines 15-21). Brandt et al. teach folding the web transversely relative to the longitudinal direction so that the fibers are arranged perpendicular to the first longitudinal direction (page 3, line

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22 - page 4, line 12 and Figures 9 and 10). Regarding the limitation that the fibrous insulation has no folds, Brandt et al. teach an embodiment where the folds are removed from the fibrous insulation material (See Figures 8-10 and page 29, line 28 - page 31, line 15). The finished product in Figure 8, as seen in the drawing, does not contain any folds. Regarding the use of "consisting essentially of" in claim 1, the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). The two outer layers shown in Figure 8 of Brandt et al. would not serve to materially affect the basic novel characteristic of the claimed invention because the insulation material of Brandt et al. still has fibers that predominately lie in planes extending substantially perpendicular to the planes of the major surfaces and the end surfaces. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870; 143 USPQ 256 (CCPA 1964). With regard to claims 2 and 5, the fibers may be glass (page 1, line 7). With regard to claim 4, binder is used to bond the fibers (page 3, line 32).

C. Claims 3 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt et al. in view of Michelsen (U.S. Patent No. 5,765,318).

Brandt et al. do not disclose using polymeric fibers. Michelsen teaches fibrous nonwoven insulation may be made from glass fibers or polymeric fibers (column 3, lines 59-66). It would have been obvious to a person having ordinary skill in the art at the

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time of the invention to use polymeric fibers in Brandt et al. in order to use fibers that are easier to process and are recyclable, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Additionally, Brandt et al. do not disclose using a binderless web. Michelsen teaches that nonwoven insulation material may be held together by fibrous entanglement (column 4, lines 2-6). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use a binderless web in the Brandt et al. insulation in order to provide an insulation material with less weight and increased compressibility, by allowing the fibers to hold together without binder, as taught by Michelsen.

(10) Response to Argument

Appellant argues the specification supports the negative limitation recited in claim 1 that the fibrous structure has "no folds therein." Appellant supports this argument by describing the processing steps by which the insulation blanket is made. Appellant asserts that the formation of the batts is completed when the blanket is cut and there is no folding of the blanket sections to form the batts of the subject of the invention. In response to this argument, the Examiner agrees that the process used by Appellant in creating the claimed product does not involve folding steps. However, one cannot provide a negative limitation in the claims based on the mere silence of that limitation in the specification. The specification is silent to the concept of excluding folds. While the product created by the process disclosed in the specification may not contain folds, nowhere is the concept of excluding folds taught. The recitation is not expressly set forth in the specification, so it is new matter.

Appellant argues that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support. However, the specification never even discusses folding, nor is the word found therein. Appellant does not have support to introduce the concept of excluding folds into the claims.

Appellant argues that Brandt et al. disclose a fiber web wherein the fibers, after being folded, retain a generally parallel orientation with respect to each other. Appellant argues that with the fiber orientation of Brandt et al., rather than the random fiber orientation in the insulation batt of the subject invention, it may be acceptable to have the fibers of the Brandt et al. mineral fiber web lying in planes that extend generally perpendicular to the major surfaces and lateral surfaces of the mineral fiber web and generally parallel to the end surfaces of the mineral fiber web. Appellant then states, "However, the randomly oriented fibers of the insulation batt 20 of the subject invention must lie in planes that are substantially perpendicular to the planes of the major surfaces and the end surfaces of the blanket and substantially parallel to the planes of the lateral surfaces of the blanket to facilitate a widthwise compression of the insulation batt 20." However, the Examiner disagrees with the characterization of how the fibers in the Brandt et al. reference are oriented. Brandt et al. do disclose that the fibers lie in planes that are substantially perpendicular to the planes of the major surfaces and the end surfaces of the blanket and substantially parallel to the planes of the lateral surfaces of the blanket. Looking at Figure 8 of Brandt et al., one sees that the fibers are oriented such that they are perpendicular to the major surface. However, Applicant's claim is directed to the orientation of the plane in which the fiber lies and not the

orientation of the fiber. One can draw a two-dimensional plane that captures any of these fibers such that the plane in which the fiber lies (and not the fiber itself) would be perpendicular to the major surfaces and the end surfaces, but also parallel to the lateral surfaces. Therefore, the insulation blanket of Brandt et al. meets the claimed limitations.

Although Appellant asserts some sort of random orientation of the fibers, this claim limitation is limited in light of the specific recitations that the fibers need to lay in particular planes. Because the fibers must lie within the stated planes according to the claims, they cannot be entirely random. The fibers of Brandt et al. lie within these claimed planes. Besides, the fibers of Brandt et al. have random orientation because they are different distances apart. Brandt et al. do not require the fibers to be equally spaced, so they possess some degree of random orientation. Applicant provides no definition to what randomly oriented specifically means to differentiate it from Brandt.

While Appellant stresses the importance of widthwise compression in the present invention, one can see that the material of Brandt et al. also undergoes widthwise compression (Figure 3c). The insulation blanket of Brandt et al. has fibers that lay in planes that meet the orientation presently claimed.

Appellant argues that Michelsen does not supplement the disclosure of Brandt et al. However, this argument does not address the grounds of rejection concerning the combination of Brandt et al. with Michelsen.

(11) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

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(12) Related Proceeding(s) Appendix

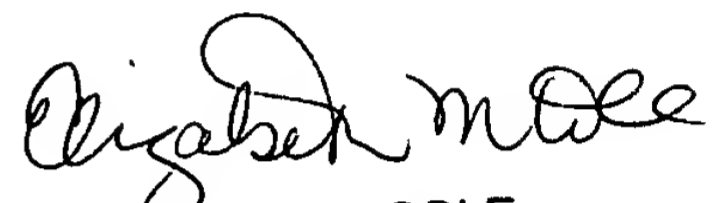
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Jeremy R. Pierce
Examiner, AU 1771
September 7, 2005



ELIZABETH M. COLE
PRIMARY EXAMINER

Conferees:

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